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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DOMINIQUE BRIERE, LEON COLSY,
PAUL La BARRE and PASCAL SANTAIS

Appeal 2009-006274
Application 09/902,475
to reissue U.S. Patent 5,968,560
Technology Center 1700

Oral Argument: July, 8 2009
Decided: August 5, 2009

Before: ALLEN R. MacDONALD, *Vice-Chief Administrative Patent Judge*, and BRADLEY R. GARRIS, *Administrative Patent Judge*, and FRED E. McKELVEY, *Senior Administrative Patent Judge*.

McKELVEY, *Senior Administrative Patent Judge*.

DECISION ON APPEAL

1 A. Statement of the case

2 Sidel S.A. of Le Havre, France ("Sidel"), the real party in interest,
3 seeks review under 35 U.S.C. § 134(a) of a second rejection (mailed 1 June
4 2007) of claims 48-51.

5 U.S. Patent 5,968,560, owned by Sidel, issued on 19 October 1999.

6 Thereafter, Sidel applied for a "first" reissue (application 09/553,413,
7 filed 20 April 2000).

The "first" reissue application matured into Re 39,769 on 14 August 2007.

The reissue application on appeal is the "second" reissue application also seeking reissue of U.S. Patent 5,968,560.

The "second" reissue application was filed on 9 July 2001 as a continuation of the "first" reissue application.

There are numerous claims in the "second" reissue application on appeal.

The Examiner has rejected only claims 48-51.

The rejection is based on the "recapture" rule.

We have jurisdiction under 35 U.S.C. § 134(a).

B. Findings of fact

The following findings of fact are supported by at least a preponderance of the evidence.

References to the specification are to U.S. Patent 5,968,560.

To the extent that a finding of fact is a conclusion of law, it may be treated as such.

Additional findings as necessary may appear in the Discussion portion of the opinion.

The invention

The Sidel invention relates to improvements in a device used to produce bottles made of a thermoplastic. The thermoplastic bottle is made by blow molding or stretch-blow molding of a thermoplastic preheated perform. The device includes at least one mold consisting of two half-molds

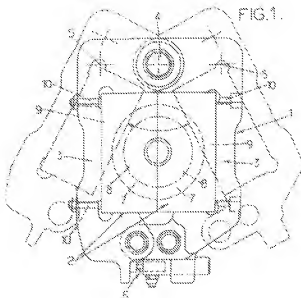
1 respectively supported by two mold carriers which can move one with
2 respect to the other. Col. 1:5-11.

3 The overall Sidel invention can be understood by references to Sidel
4 Figs. 1-3, reproduced below.

5 Fig. 1 is a diagrammatic view from above of part of a molding device
6 designed in accordance with the Sidel invention. Col. 3:30-31.

7 Fig. 2 is a front view of a two-piece half-mold of the device in Fig. 1.
8 Col. 3:32-33.

9 Fig. 3 is a view from below of a half-mold in Fig. 2. Col. 3:34.



Sidel Fig. 1

Fig. 1 depicts a diagrammatic view from
above of part of a molding device

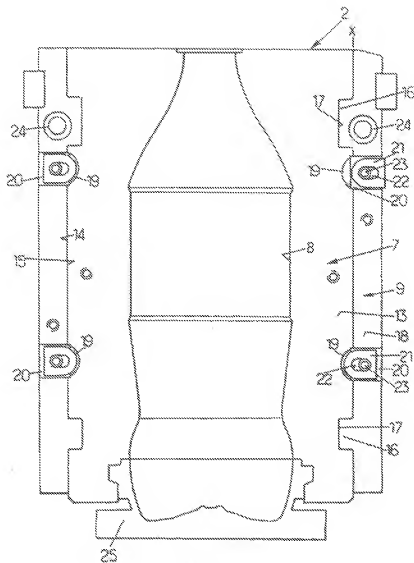
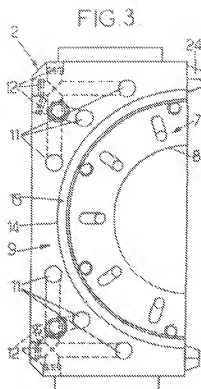


FIG. 2 .

1
2
3
4
5

Sidel Fig. 2

Fig. 2 depicts a front view of a two-piece half-mold
of the device shown in Fig. 1



Sidel Fig. 3

Fig. 3 depicts a view from below a half-mold shown in Fig. 2

Fig. 1 shows part of a device for manufacturing containers, for example, bottles of a thermoplastic such as polyethylene terephthalate (PET), by blow molding or stretch-blow molding a PET preheated preform. Col. 3:37-42.

The device includes at least one mold 1 consisting of two half-molds 2 respectively supported by two mold carriers 3 which can move one with respect to the other. In Fig. 1, the two mold carriers 3 are made in the form of two enveloping structures pivotally mounted on a common rotation axis 4

1 in such a way that the two half-molds can move apart by pivoting.

2 Col. 3:43-53.

3 Locking means, denoted in its entirety by 6 (bottom of Fig. 1), locks
4 the two half-molds in the closed, molding position. Col. 3:54-55.

5 Each half-mold is described as being made in the form of two
6 subassemblies, namely (1) a shell 7 provided with a half-impression 8 of the
7 container to be manufactured and (2) a shell holder 9 which supports the
8 shell 7 and which is itself fastened to (3) a corresponding mold carrier 3.

9 Col. 3:56-60. At col. 3:60, the patent refers to the mold carrier as item 2.

10 We believe reference to 2 is a mistake given that throughout the patent the
11 mold carrier is referred to as item 3. See, e.g., col. 3:46 and 64 and
12 col. 5:55. We also note that at col. 4:51 item 2 is referred as a half-mold.

13 Each shell holder is provided with internal pipes 11 and with fittings
14 12 which are necessary for the circulation of at least one fluid for cooling or
15 heating the wall of the impression. Fig. 3 and col. 4:14.

16 In the example shown in FIG. 2, the container to be produced has a
17 bottom of complex shape and the requirements for demolding the container
18 after it has been formed result in the provision of a separate mold bottom 25,
19 distinct from the half-molds 2, which includes the impression of the bottom
20 of the container. Col. 4:47-52.

21 Once the shell 7 has been placed in the shell holder 9, it can no longer
22 move axially with respect to the latter but can only slide rotationally about
23 its axis on the cradle 15. Col. 4:63-64.

24 In order fully to lock the shell onto the shell holder, quick-fixing

means are provided in the parting face 13 of the shell and in the parting face 18 of the shell holder. Respective housings 19 and 20, hollowed out in the facing edges of the parting faces 13 and 18, respectively, are provided. The bottoms of the housings 19 of the shell 7 constitute flat bearing surfaces on which may bear members for locking the shell holder 9. These locking members may be formed in many ways known to those skilled in the art. Shown in Fig. 2 are lugs 21 drilled with an elongate hole 22 and retained by a screw 23 fixed to the bottom of the corresponding housing 20 of the parting face 18 of the shell holder 9. Col. 4:66 to col. 5:12.

Prosecution history

The application maturing into the patent owned by Sidel was filed in the USPTO on 17 October 1997.

Claim 1 of the application read (application 08/945,089, specification, page 10 [numbers referring to drawing elements in parenthesis in original]):

Device for manufacturing containers, in particular bottles, made of a thermoplastic by blow molding or stretch-blow molding of a preheated preform, the said device including at least one mold (1) consisting of two half-molds (2) respectively supported by two mold carriers (3) which can move one with respect to the other, characterized in that each half-mold (2) comprises a shell holder (9) supported by the respective mold carrier (3) and a shell (7) which is provided with a half-impression (8) of the container to be obtained and which can be removably fastened to its shell holder (9) by quick-fixing means (19-23),

1 the shell (7) and the shell holder (9) being in
2 complementary shapes in order to be in at least partial mutual
3 thermal-conduction contact while the pipes and
4 connections for the circulation of cooling and/or heating
5 fluids (11, 12) are provided exclusively in the shell holder.

6 There came a time during prosecution when the Examiner rejected
7 claim 1.

8 Two rejections relevant to this appeal were made.

9 *First*, claim 1 was rejected as indefinite. The Examiner, relying on
10 Board precedent, held that the language "in particular bottles" rendered the
11 claim 1 indefinite because claim 1 included both a broad recitation
12 ("containers") and a narrow recitation ("in particular bottles"). Application
13 08/945,089, Paper 4, pages 2-3.

14 *Second*, claim 1 (as well as other claims) was rejected as being
15 unpatentable under 35 U.S.C. § 103(a) over Appel (U.S. Patent 4,072,456)
16 and Schavoir (U.S. Patent 1,409,591). Application 08/945,089, Paper 4,
17 pages 4-5.

18 Sidel timely responded with an AMENDMENT UNDER 37 C.F.R.
19 § 1.115. Application 08/945,089, Paper 6.

20 Sidel amended claim 1 to read (Paper 6, page 2) (deletion from
21 original claim 1 shown in strikethrough; additions to original claim 1 shown
22 in bold]:

23 Device for manufacturing containers, ~~in particular~~
24 **bottles**, made of a thermoplastic by blow molding or stretch-
25 blow molding of a preheated preform, the said device including

1 at least one mold (1) consisting of two half-molds (2)
2 respectively supported by two mold carriers (3) which are
3 made in the form of enveloping structures and which can
4 move one with respect to the other,
5 characterized in that each half-mold (2) comprises a shell
6 holder (9) supported by the respective mold carrier (3) and a
7 shell (7) which is provided with a half-impression (8) of the
8 container to be obtained and which can be removably fastened
9 to its shell holder (9) by quick-fixing means (19-23),
10 the shell (7) and the shell holder (9) being in
11 complementary shapes in order to be in at least partial mutual
12 thermal-conduction contact while the pipes and
13 connections for the circulation of cooling and/or heating
14 fluids (11, 12) are provided exclusively in the shell holder.

15 In REMARKS, Sidel noted that "Claim 1 has been amended for
16 clarity to delete the reference to bottles. Paper 6, page 3. The amendment
17 overcame the § 112 rejection.

18 Sidel also urged that the rejection of claim 1 (and other claims) as
19 being unpatentable over Appel and Schavoir "is respectfully traversed."
20 Paper 6, page 5:4-6. The "presently claimed invention" (page 6:9) was said
21 to "patentably distinguish over each of the cited references ..." Page 6:7-8.
22 Amended claim 1 was said to define "a structure with mold carriers 3 which
23 envelope or surround shell holders 9, wherein mold-carriers 3 are movable
24 one with respect to the other" Paper 6, page 5:20-23 last four lines.
25 Appel and Schavoir were said not to teach or suggest a combination of

(1) an enveloping mold carrier, (2) a shell holder and (3) a shell. Paper 6, page 7:6-10. For a brief explanation of "enveloping structure," see Record of oral hearing, page 13:11 through page 14:7.

Upon consideration of the amendment, the Examiner entered a first Notice of Allowability. Application 08/945,089, Paper 9. Claim 1 (as well as other claims) was indicated as being allowable.

Thereafter, Sidel submitted another amendment adding a claim 14 and the Examiner then entered a second Notice of Allowability. Application 08/945,089, Paper 11.

U.S. Patent 5,968,560, containing claim 1 as amended issued on 19 October 1999.

Second reissue application claims 48-51

At oral argument, counsel for Sidel confirmed that, with respect to the Examiner's recapture rejection, claims 48-51 stand or fall together. Record of oral hearing, page 15:10-13.

Claim 48 reads [drawing numbers added]:

A mold shell assembly for use in manufacturing molder thermoplastic contains comprising:

a mold bottom defining an impression of a base portion of a container to be molded; and

a pair of mold shells 7 each defining a half impression of a substantial portion of said container to be molded, said mold shells 7 being configured to be supported by mold carriers 3 made in the form of enveloping structures via interposed mold shell holders 9, said mold shell holders 9 being shaped to be

1 supported by said mold carriers 3 made in the form of
2 enveloping structures,
3 said mold shells further defining one or more bearing
4 surfaces sized and shaped to receive a quick-fixing locking
5 member including a selectively retractable locking member
6 portion for removably securing said mold shells to a respective
7 one of said mold shell holders, and
8 said mold shells further defining out walls shaped to be
9 in a least partial mutual thermal-conduction contact with said
10 mold shell holders.

11 Examiner's rejection

12 The Examiner rejected claims 48-51 under 35 U.S.C. § 251 based on
13 the recapture rule. Examiner's Answer, page 3-4. In the Examiner's opinion,
14 claim 48 did not require the presence of a mold carrier. Since mold carriers
15 made in the form of enveloping structures are required by claim 1 of the
16 Sidel patent, the Examiner concluded that Sidel is improperly recapturing
17 subject matter surrendered to secure allowance of claim 1.

18 Sidel's Appeal Brief, Reply Brief and oral arguments

19 Sidel based its Appeal Brief argument on a decision of the Board
20 entered in the "first" reissue application. *Ex parte Briere*, Appeal 2006-0123
21 (Bd. Pat. App. & Int. Feb. 24, 2006). *Briere* reversed a recapture rejection
22 of a claim 15 which did not require a mold carrier. Claim 15 called for a
23 mold assembly comprising two elements: (1) two mold shells 7 and (2) two
24 mold shell holders 9. In other words, claim 15 did not require mold carriers
25 3, but did require two mold shells 7 and two mold shell holders 9. The mold

1 shell holders 9 had to be shaped to be supported by two mold carriers made
2 in the form of enveloping structures. Claim 1 of the Sidel patent requires
3 three elements: (1) two mold carriers 3 made in the form of enveloping
4 structures, (2) two mold shells 7 and (3) two mold shell holders 9.

5 The subject matter of claim 48 on appeal is said to be a
6 "subcombination" of the "combination" of claim 1 of the patent. Appeal
7 Brief, page 7:10. Since the subject matter of claim 15 in *Briere* was also a
8 subcombination of the combination of claim 1 of the patent, Sidel reasons
9 that the holding of *Briere* is applicable to the facts of this case. According to
10 Sidel, the *Briere* panel determined—on the record before it—that the
11 original application "implicitly limited the shape of the mold shells to shapes
12 that can be supported by ... enveloping mold carriers." Appeal Brief,
13 page 7:26 to page 8:1. See also Reply Brief, page 3:5-8.

14 At oral argument in response to questions from the bench, counsel for
15 Sidel told us that a combination of a mold shell assembly sans a mold carrier
16 would infringe claim 48 on appeal. Record of oral hearing, page 3:18 to
17 page 4:5. Specifically, all claim 48 on appeal requires is that the mold shell
18 be capable of being used in mold carriers made in the form of enveloping
19 structures. Record of oral hearing, page 4:1-5. As long as a mold shell can
20 be used in mold carriers made in the form of enveloping structures, the mold
21 shell would fall within the scope of claim 48 on appeal even if it could be
22 used in different mold carriers. Accordingly, we will decide the appeal on
23 the basis that claim 48 on appeal does not require a mold carrier.

24 At oral argument and in response to questions from the bench, we
25 understand counsel for Sidel to have further told us that claim 48 was in no

1 respects narrower than claim 1 of the patent. Record of oral hearing,
2 page 15:17 to page 16:15. Accordingly, we will decide the appeal on the
3 basis that claim 48 on appeal is broader in all respects than claim 1 of the
4 patent.

5 We decide the appeal on the basis of what counsel told us in the
6 Appeal Brief and Reply Brief, as further embellished at oral argument.

7 C. Discussion

8 In our view, the appeal is governed by principles discussed in *In re*
9 *Clement*, 131 F.3d 1464 (Fed. Cir. 1997).

10 In a nut shell, Sidel obtained allowance of claim 1 of the patent. The
11 claim covers a three-element combination of (1) mold carrier 3, (2) mold
12 shell 7 and (3) mold shell holder 9. In order to get claim 1 allowed, Sidel
13 had to limit the mold shell carrier 3 to those "which are made in the form of
14 enveloping structures".

15 Claim 48 on appeal cover a two-element combination of (2) a mold
16 shell 7 and (3) a mold shell holder 9 sans any requirement for a (1) mold
17 carrier 3—whether or not the mold carrier is one which is made in the form
18 of enveloping structures. Record of oral hearing, page 3:19 to page 4:5.

19 The appeal involves application of *Clement* Rule 1: "if the reissue
20 claim is as broad as or broader than the ... amended claim in all aspects, the
21 recapture rule bars the claim." 131 F.3d at 1470.

22 Not only has Sidel eliminated a requirement for enveloping structures,
23 it has eliminated the need for a mold shell carriers altogether.

24 Sidel's principal argument seems to be that the same result should be
25 reached in this appeal as was reached in *Briere* Appeal 2006-0123. The

1 *Briere* panel did not discuss the applicability of *Clement*. Counsel for Sidel
2 was asked why the "logic [of *Briere*] is right on the merits." Record of oral
3 hearing, page 11:10-11. No cogent response was received. Furthermore,
4 we are not sure if Sidel told the *Briere* panel whether the claims before it
5 could be infringed by a device without a mold carrier. So it is not entirely
6 clear that the issues are identical. We conclude discussion of Sidel's reliance
7 on *Briere* by noting that if *Briere* is inconsistent with the decision we reach
8 today, we respectfully disagree with the *Briere* panel. In our view, our
9 decision is governed by *Clement*—which of course, is binding on the Board
10 and which was not mentioned by the *Briere* panel.

11 We make one final observation. We were told at oral argument that
12 claim 48 is broader in all respects than patent claim 1. We decide appeals on
13 the issues presented and do not undertake a *de novo* review of the record to
14 see if there is some theory upon which an appellant might prevail. Sidel did
15 not call our attention to locking members mentioned in claim 48 and
16 therefore has waived any right to rely on locking members as being a
17 narrowing limitation. In any event, the locking members seem to be present
18 in patent claim 1 and, in any event, can hardly be called an overlooked
19 aspect given that Sidel concedes that locking members may be formed in
20 many ways known to skilled in the art. Col. 5:6-8.

21 We have considered Sidel's remaining arguments and find none that
22 warrant reversal of the Examiner's rejections. *Cf. Hartman v. Nicholson*,
23 483 F.3d 1311, 1315 (Fed. Cir. 2007).

1 D. Decision

2 Sidel has not sustained its burden on appeal of showing that the
3 Examiner erred in rejecting the claims on appeal as being unpatentable based
4 on the recapture rule.

5 On the record before us, Sidel is not entitled to a reissue patent
6 containing claims 48-51.

7 Upon consideration of the appeal, and for the reasons given
8 herein, it is

9 ORDERED that the decision of the Examiner rejecting claims
10 48-51 based on the recapture rule is *affirmed*.

11 FURTHER ORDERED that no time period for taking any
12 subsequent action in connection with this appeal may be extended under
13 37 C.F.R. § 1.136(a)(1)(iv) (2008).

AFFIRMED

ack

cc (via First Class mail)

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